

Response Under 37 CFR 1.116

Expedited Procedure

Examining Group 3700

Application No. 10/706,503

Paper Dated February 16, 2007

In Reply to USPTO Correspondence of November 16, 2006

Attorney Docket No. 4366-032163

REMARKS

The final Office Action of November 16, 2006 has been reviewed and the Examiner's comments carefully considered. Claim 1 was withdrawn from consideration by the Examiner in view of an earlier restriction requirement. The Applicant reserves the right to file a divisional application directed to the non-elected claim. Accordingly, claims 2-4 were examined on their merit in this application, and claim 2 is in independent form.

35 U.S.C. §103 Rejections

Claims 2-4 stand rejected under 35 U.S.C. §103(a) for obviousness based upon United States Patent No. 6,450,175 to Park (hereinafter "the Park patent") in view of United States Patent No. 4,369,098 to Van Roeyen (hereinafter "the Van Roeyen patent"). In view of the following remarks, the Applicant respectfully requests reconsideration of this rejection.

As defined by independent claim 2, the present invention is directed to a method of manufacturing a filing tool for hardened-skin care comprising a plurality of filing parts formed on a metal plate. The method includes a first step of setting a patterned photosensitive dry film on the metal plate; a second step of exposing the metal plate set with the dry film to light; a third step of removing a non-exposed portion of the dry film to form a masking pattern; a fourth step of plating nickel on the metal plate formed with the masking pattern to form a first nickel-plated layer, followed by uniformly applying stone powders on the first nickel-plated layer; a fifth step of further plating nickel on the stone powders to form a second nickel-plated layer thereby fixing the stone powders between the first nickel-plated layer and the second nickel-plated layer; and a sixth step of removing the masking pattern.

The Park patent, which is the United States equivalent of Korean Utility Model No. 20-0253679 cited in the Applicant's specification on page 2, line 14, is directed to a nail care instrument with abrasive portions formed by an electroplating process. The nail care instrument includes a base (6) of synthetic resin, a copper film (3) coated on one surface of the base (6), a plurality of release recesses (2) formed in the copper film (3), and abrasive portions (1) formed on the copper film (3). The abrasive portions are formed by electroplating an abrasive substance, such as white alumina, on the copper film (3) (see Fig. 4).

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Independent claim 2 requires the step of “plating nickel on the metal plate ... to form a first nickel-plated layer, followed by uniformly applying stone powders on the first nickel-plated layer”. The Park patent, on the other hand, discloses that nickel and alumina particles are electroplated onto the copper film simultaneously (see column 3, lines 8-18). Accordingly, the Park patent does not teach or suggest the step of “plating nickel on the metal plate ... to form a first nickel-plated layer, followed by uniformly applying stone powders on the first nickel-plated layer” as required by independent claim 2. The Van Roeyen patent does not cure this deficiency. The Van Roeyen patent is directed to a method of manufacturing abrasive articles and does not teach or suggest the claimed step of “plating nickel on the metal plate ... to form a first nickel-plated layer, followed by uniformly applying stone powders on the first nickel-plated layer”.

Furthermore, as the Examiner admits on page 2 of the Office Action, the Park patent fails to teach or suggest a step of further plating nickel on the stone powders to form a second nickel-plated layer fixing the stone powders between the first and second nickel-plated layers as required by independent claim 2. The Examiner contends that the Van Roeyen patent discloses such a step. However, as clearly illustrated in Fig. 1 of the Van Roeyen patent, the abrasive granules (18) are completely enveloped within a base layer (17) of resin material. Thereafter, a plurality of electroplated-metal layers (19, 20 and 21) are formed on the base resin layer (17). Therefore, the Van Roeyen patent does not teach or suggest the step of fixing stone powders between a first nickel-plated layer and a second nickel-plated layer as required by independent claim 2. Instead, the abrasive granules (18) (i.e., stone powders) of the Van Roeyen patent are enveloped in a base layer (17) of resin material.

Additionally, while the Park patent discloses that the abrasive portions are formed by electroplating an abrasive substance (i.e., nickel and alumina particles mixed in a plating solution) on the copper film formed by corrosion, this reference does not teach or suggest the second nickel-plated layer on the stone powders in order to fix the stone powders (serving as a filing material) more securely between the first nickel-plated layer and the second nickel-plated layer on a metal plate as required by independent claim 2.

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When evaluating a claim for determining the question of obviousness, all of the limitations of the claim must be evaluated. Where claimed limitations are simply not present in the prior art, a *prima facie* obviousness rejection is not supported. Accordingly, since the combination of the Park patent and the Van Roeyen patent fail to teach or suggest several limitations of independent claim 2 as discussed above, a *prima facie* case of obviousness has not been established.

For the foregoing reasons, the Applicant believes that the subject matter of independent claim 2 is not rendered obvious by the Park patent in view of the Van Roeyen patent. Reconsideration and withdrawal of the rejection of claim 2 are respectfully requested.

Claims 3 and 4 depend from and add further limitations to independent claim 2 and are believed to be patentable for the reasons discussed hereinabove in connection with independent claim 2. Reconsideration and withdrawal of the rejection of claims 3 and 4 are respectfully requested.

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 2-4 are respectfully requested.

Respectfully submitted,

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